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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,221	08/18/2000	Ryukou Arisawa	32892	6271

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EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/642,221	Applicant(s) ARISAWA ET AL.	
	Examiner Charles N. Appiah	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 11-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims 1-10 are directed to a portable cellular telephone having the capability of downloading an application software corresponding to a music data format as defined in connection with music received from a remote service while the newly submitted claims 11-20 are directed to the specific details of a portable terminal such as a storage for storing a reproducing application and content data, an identifying portion, a searching portion and instructing portion. The inventions of claims 11-20 and 1-10 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the portable cellular phone having the capability of downloading an application software corresponding to a music data format as defined in connection with music data received from a remote server does not require the details of a portable terminal such as a storage portion, an identifying portion, a searching portion and instructing portion needed to instruct a server to transmit reproducing information about a reproducing application that enables the reproduction of an identified content data that

is not stored in the storage portion. The subcombination has separate utility such as remote downloading of music format data.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emiko (JP 10-173737) in view of the Article "Subscribers to NTT DoCoMo 's I-Mode Service Top 1 Million", August 16, 199, World Reporter, Comline Telecommunications (hereinafter referred to as 'The Article').

Regarding claims 1, 6 and 8 Emiko a portable cellular phone and a method of operating a portable cellular phone comprising: a music data retrieving means, which retrieves music (selection means that selects a desired tone, see abstract). Emiko teaches the portable telephone downloads music data of the incoming call tone selected by the selection means from the central server, see abstract), but fails to explicitly teach

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a downloading means which downloads an application software corresponding to a music data format defined in connection with the music data from a remote server.

In an analogous field of endeavor, The Article discloses that NTT DoCoMo may introduce a service that enables subscribers to use their cellular phones to download game and music software from the Internet wherein the expanded convenience of such service is sure to attract new subscribers (see the Article).

It would therefore have been obvious to one of ordinary skill in the art to incorporate the above teaching of downloading music software to mobile or wireless telephone devices into Emiko's communication unit in order to provide the expanded convenience to cellular subscribers.

Regarding claim 2 and 9 Emiko as modified by the Article further discloses wherein the retrieving means retrieves the music data from a storage medium (see Emiko, selection of desired tone by the user among various and diversified incoming call tone stored in a center server, see abstract) and inherent feature of downloading from the Internet as taught by the Article.

Regarding claims 3, 7 and 10, Emiko as modified by the Article further teaches wherein the retrieving means retrieves the music data (application software) via a communication means (wireless communication means) (user choosing desired sound from two or more tones stored in the pin center, the means for communications for obtaining the music data of the ringer tone chosen by this selection means from the pin center, see claim 1, CLAIMS and mobile radiotelephone network, a cellular-phone

network, see MEANS, page), and inherent feature of using cellular phone to download from the Internet as taught by the Article.

Regarding claims 4 Emiko further discloses an application software executing means which executes the application software in association with the music data in the cellular phone (pronouncing of ringer tone according to music data concerned by reading music data from the music data carrier of the music box chip, see MEANS paragraph 0007, page 1 of 3).

Regarding claim 5, Emiko's teaching of the pronunciation means pronouncing a ringer tone according to the music data concerned while reading music data from the music data carrier concerned, claim 4 of CLAIMS), reads on the application software executing means executes a plurality of pieces of application software in parallel simultaneously in association with the music data.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. UK Government: Mobile Phones – The next generation, "M2 Presswire". Coventry: May 7, 1999, page 1 discloses phones that allow users surf the Internet and rapidly download emails, music and high quality pictures.

Hsu et al. (6,587,684) discloses a digital wireless telephone system for downloading software.

Leermakers (6,928,468) discloses a communication system that broadcasts software applications to portable devices.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA


CHARLES APPIAH
PRIMARY EXAMINER